

The opinion in support of the decision being entered today was not
written for publication and is not binding precedent of the Board.

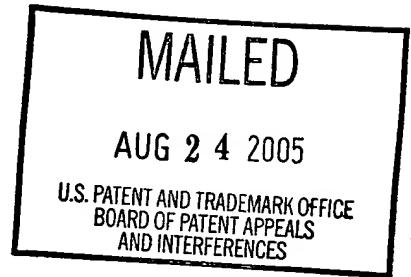
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JOSEPH A. YACCARINO, III, ARTHUR A. GERTZMAN,
and RAYMOND G. FERRARA

Appeal No. 2005-1370
Application No. 09/503,166

HEARD: JULY 13, 2005



Before MCQUADE, CRAWFORD, and BAHR, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 12 and 29 to 32, which are all of the claims pending in this application. Claims 13 to 28 and 33 to 37 have been canceled.

The appellants' invention relates to a composite allograft bone device constructed from two or more separate bone pieces that can be fastened together for

implantation in a surgical site (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

THE PRIOR ART REFERENCES

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Reed	5,968,047	Oct. 19, 1999
Paul et al. (Paul)	6,258,125	Jul. 10, 2001
		(filed Jul. 30, 1999)

THE REJECTION

Claims 1 to 12 and 29 to 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Paul in view of Reed.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed Jan. 13, 2004) for the examiner's complete reasoning in support of the rejection, and to the brief (filed November 24, 2003) and reply brief (filed March 15, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection in this case is made pursuant to 35 U.S.C. § 103. We initially note that the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993).

The examiner finds:

Paul et al. teaches an intervertebral allograft spacer (50, 80) with portions (52, 54) having complimentary [sic, complementary] and interlocking mating surfaces (56, 58, 82, 84, 86) with plurality of angularly aligned holes (66) and pins (64) as is claimed (Abstract, figures 6-8B and 11, column 2[,] lines 13-43, column 3[,] lines 26-59, column 4[,] lines 27-67 and column 5[,] lines 1-7). [Answer at page 4.]

As conceded by the examiner, Paul does not describe that the fastener is threaded, as recited in claim 1, is a threaded bolt as recited in claim 4, includes a nut as recited in claims 6, 7, 10, 11, is a knurled rod as recited in claim 31, or has a demineralized outer surface as recited in claims 29 and 30. To account for these differences, the examiner relies on Reed and finds that:

Reed teaches different type[s] of demineralized fixation devices such as a screw (80) or rod (90, 100)(Figures 20A and 21A-22, column 2[,] lines 18-67, column 3[,] lines 9-26, column 5[,] lines 28-67 and column 6[,] lines 1-14). [Answer at page 4.]

The examiner concludes that it would have been obvious to modify the apparatus of Paul to include a threaded fastener, a threaded bolt, a nut, a knurled rod or a rod with a

demineralized outer surface, the motivation being to better secure the implant and to obtain the advantages of prevention of immune system response achieved by demineralized devices.

Appellants argue that the Paul reference is not a valid prior art reference because it has been sworn behind by a 37 CFR § 1.131 declaration filed by an inventor.

Section 1.131(a) of 37 CFR provides, in relevant part, that when any claim of an application is rejected, the inventor of the subject matter of the rejected claim may submit a declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference on which the rejection is based. Section 1.131 requires:

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained. [Emphasis added.]

The purpose of Rule 131 is to allow an applicant to "demonstrate that the applicant's date of invention is prior to the effective date of the reference cited in support of a rejection." In re Asahi, 68 F.3d 442, 445, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995), citing In re Eickmeyer, 602 F.2d 974, 978, 202 USPQ 655, 660 (CCPA 1979). This rule requires:

. . . that facts be offered which show "completion of the invention" prior to the effective date of the reference in order to establish *prima facie* a case of prior inventorship. The term "completion" is further defined by the requirement of subsection (b) of Rule 131 that the facts must establish either reduction to practice, or conception coupled with due diligence until a subsequent actual reduction to practice or the filing of the application. The requirement for such *facts* in establishing *prima facie* a case of prior inventorship has been articulated in the decision of this court in *In re Garratt*, 63 F.2d 113, 115, 20 CCPA 878, 882, 16 USPQ 369, 372. See *Ex Parte Stalego*, 135 USPQ 37, 38 (Pat. Off. Bd. App. 1961).^[1]

Proof of prior completion of the claimed invention includes "showing what the reference shows . . . [and] possession of either the whole invention claimed or something falling within the claim, in the sense that the claim as a whole reads on it" prior to the effective date of the prior art reference. *In re Spiller*, 500 F.2d 1170, 1177, 182 USPQ 614, 619 (CCPA 1974); *In re Tanczyn*, 347 F.2d 830, 832-33, 146 USPQ 298, 301 (CCPA 1965); 37 CFR § 1.131 (2000).

The declaration which was executed by one of the inventors states at paragraph 4 that Joseph A. Yaccarino "worked upon, developed and was an inventor of the device which is substantially shown in Figures 7, 8, 8A and 11 of the '125 patent."² However, it is not clear from this statement in the declaration what the inventor worked upon or developed, because it is not known what is meant by the word "substantially." In addition, as this statement is not accompanied by original exhibits or drawings or

¹ See *In re Clarke*, 356 F.2d 987, 990-91, 148 USPQ 665, 669 (CCPA 1966).

² The '125 patent is the Paul reference.

records as a showing to prove these facts as required by 37 CFR § 1.131(b), we can not accord substantial weight to this statement.

The declaration also states at paragraph 6 that substantially the same device shown in the drawings of Figures 7, 8, 8A, and 11 of the Paul reference was conceived and reduced to practice prior to the provisional filing date of August 13, 1998 of the Paul reference. This statement suffers from the same problems we noted in our discussion of paragraph 4 of the declaration in regard to the word "substantially." In addition, the statement does not address who conceived and reduced to practice whatever it was that was conceived and reduced to practice. In order to swear behind the Paul reference, the inventor must establish that he conceived and reduced the invention to practice before the effective date of the Paul reference.

The declaration also states that the inventor of the Paul reference, one of the present inventors (Joseph Yacharino), the assignee of the Paul reference and the assignee of the present invention collaborated on various related and unrelated applications. However, the appellants have not demonstrated the relevancy of these connections to the reduction to practice of the present invention prior to the effective date of the Paul reference.

After review of the declaration of the inventor, it is our opinion that the declaration is not of sufficient weight and character to establish reduction to practice of the invention prior to the effective date of the Paul reference. Therefore, the Paul reference is prior art to the appealed claims.

Having determined that the Paul reference is prior art to the appellants' claims, we now address appellants' arguments regarding the substance of the rejection.

Appellants argue that there is no disclosure in Reed of fasteners used to hold two or more preshaped bone members together to form a compound bone device made from smaller bone members. This argument is not persuasive because Paul is relied on for teaching using fasteners to hold two or more preshaped bone members together and nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co., 800 F.2d 1091, 1097-98, 231 USPQ 375, 380 (Fed. Cir. 1986).

Appellants also argue that neither reference discloses a rod member with a demineralized surface as recited in claims 29 and 30, or a rod member with a knurled outer surface as recited in claim 31.

We do not agree. Reed clearly teaches a rod member with a demineralized surface (col. 6, lines 1 to 5), and a rod member with a knurled outer surface (Fig. 21A, col. 9, lines 36 to 40).

In view of the foregoing, we will sustain the examiner's rejection of claims 1 to 12 and 29 to 31.

We agree with the appellants that the cited references do not disclose, teach or suggest a fastener which is a wedge nail with an angular cross section. Therefore, we will not sustain the rejection as it is directed to claim 32.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART



JOHN P. MCQUADE
Administrative Patent Judge



MURRIEL E. CRAWFORD
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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